REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments and the following remarks. Claims 1-3, 12, 14-18, 21-23, 25, 26, 34-36, 38, 39, 47-51 and 55 were pending in the present application. Claims 1-3, 12, 14-18, 21-23, 25, 26, 34-36, 38, 39, 47-51 and 55 are subject to a restriction requirement. Claims 1-3, 12, 14-18, 21-23, 25, 26, 34-36, 38, 39, 47-51 and 55 have been canceled. New Claims 56-73 have been added. Claims 56-73 are currently pending.

Claims 1-3, 12, 14-18, 21-23, 25, 26, 34-36, 38, 39, 47-51 and 55 have been canceled without prejudice to filing a divisional application directed to the subject matter claimed therein.

New Claims 56, 61, 64 and 70 are supported by original Claims 1, 21, 22 and 48 respectively, and correspond to original Claims 1, 21, 22 and 48 wherein "or II" and the compound of structural formula II have been deleted, and wherein all of the anti-obesity agents except for the NPY1 antagonist have been deleted. Support for narrowing these claims to the compound of formula I is found on page 11, line 1 to page 13, line 1 of the specification and in original Claim 12. Support for the NPY1 antagonist as the anti-obesity agent in Claims 56, 61, 64 and 70 is found on page 31, lines 29-34 of the specification, and in original Claim 1 as anti-obesity agent (8).

New Claims 57, 62, 65 and 71 are directed to compositions and methods wherein the NPY1 antagonist is J-115,814, or a pharmaceutically acceptable salt or ester thereof. Support for the selection of J-115,814 as the NPY1 antagonist is found on page 31, line 33 of the specification.

New Claims 59, 63, 66, and 72 are directed to compositions and methods wherein the NPY5 antagonist is 3-oxo-N-(5-phenyl-2-pyrazinyl)-spiro[isobenzofuran-1(3H),4'-piperidine]-1'-carboxamide, or a pharmaceutically acceptable salt or ester thereof. Support for the selection of 3-oxo-N-(5-phenyl-2-pyrazinyl)-spiro[isobenzofuran-1(3H),4'-piperidine]-1'-carboxamide as the NPY5 antagonist is found on page 20, lines 12-14 of the specification, and in original Claim 14 as compound (1).

New Claim 58 corresponds to original Claim 14. New Claim 60 corresponds to original Claim 18. New Claim 67 corresponds to original Claim 23. New Claim 68 corresponds to original Claim 25. New Claim 69 corresponds to original Claim 26. New Claim 73 corresponds to original Claim 47.

No new matter has been added to the above-captioned application by the amendments.

RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

The Examiner has stated that restriction is required under 35 U.S.C. 121 and 372. The Examiner indicated that the applicant is required to elect a single invention to which the claims must be restricted:

Group I: claims 1-3, 12, 14-18, 47 and 49, drawn to a product comprising (a) a NPY5 antagonist and (b) an anti-obesity agent; and

Group II: claims 21-23, 25-26, 34-36, 38-39, 48, 50, 51 and 55, drawn to a method of treatment comprising the administration of a composition comprising (a) a NPY5 antagonist and (b) an anti-obesity agent.

The Examiner stated that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: the common technical feature among the above groups is a NPY5 antagonist. The Examiner stated that this element cannot be a special technical feature under PCT Rule 13.2 because NPY5 antagonist is known in the art (Fukami et al.) and disclosed in the art for the treatment of obesity.

Applicants have canceled Claims 1-3, 12, 14-18, 21-23, 25, 26, 34-36, 38, 39, 47-51 and 55. Applicants have added new Claims 56-73. New Claims 56-60 and 73 are composition and kit claims, wherein the NPY5 antagonist is a compound of structural formula I, that correspond to the claims in Group I. New Claims 61-72 are method claims that correspond to the claims in Group II.

Applicants submit that new claims 56-73 are directed to compositions of a NPY5 antagonist of formula I and a NPY1 antagonist, and uses thereof. The special technical feature of the claims in groups I and II is the composition comprising a NPY5 antagonist of formula I and a NPY1 antagonist.

For proper restriction, two criteria must be met: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants submit that there is no serious burden in combining the restricted groups into one search. A search of the composition claims of Group I would also provide search results relating to the Group II methods of using the Group I compositions. Consequently, it would be more efficient for the Examiner to search all of the claims of Groups I and II together.

Applicants further submit that the restriction requirement should be removed because Groups I and II are linked to form a single invention since the claimed compositions involve a common therapeutic benefit of being useful to treat disorders associated with excessive food intake, including obesity and obesity related disorders. Applicants submit that the Examiner has not shown how the composition claims in Group I are independent from the method of use claims in Group II. The term "independent" means that there is no disclosed relationship between the two or more subjects disclosed. MPEP 802.01 (August 2001).

Applicants submit that there is a disclosed relationship between the method of treatment claims of Group II and the composition claims of Group I. The method of treatment claims of Group II are drawn to uses for the compositions claimed in Group I. The method claims are therefore not independent.

Accordingly, the inventions of Group I and II are not independent and Applicants respectfully request that all the claims after the foregoing amendments be examined together.

Applicants are required under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims will be restricted if no generic claim is finally held to be allowable.

Applicants hereby provisionally elect to prosecute the invention and claims of Group I, drawn to a product comprising (a) a NPY5 antagonist and (b) an anti-obesity agent, with traverse.

For Group 1 the applicants hereby elect the following species:

A composition comprising a NPY5 antagonist and (a1) an anti-obesity agent where the NPY5 antagonist is a compound of formula I. Applicants hereby elect 3-oxo-N-(5-phenyl-2-pyrazinyl)-spiro[isobenzofuran-1(3H),4'-piperidine]-1'-carboxamide as the single compound of formula (I).

Applicants are further required to elect a further species for the anti-obesity agent in the composition. Applicants hereby elect NPY1 antagonist as (b3) an anti-obesity agent in the list of Claim 1. Applicants hereby elect J-115814 as the single NPY1 antagonist.

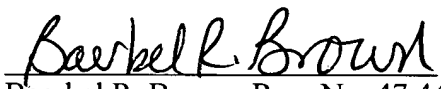
New claims 56-73 read on the composition containing the elected species. The following canceled claims also read on the composition containing the elected species: 1, 14, 18, 21, 22, 23, 25, 26, 47, and 48.

Applicants make the above election with the understanding that, if the elected species (ie. composition) is found to be allowable, the Examiner will examine the genus claims readable thereon and a reasonable number of disclosed species in addition to the elected species. In addition, new Claims 56-73 should be examined with the claims of Group I since they are dependent on Claim 1.

In light of the above reasons, Applicants respectfully request that the requirement for restriction between Groups I and II be withdrawn. In the event that the restriction requirement is made final, Applicants elect Group I, as indicated, holding Group II in abeyance for further prosecution in a divisional application.

Applicants believe that all of the objections and rejections have been overcome by amendment and/or argument, and therefore earnestly solicit an early Notice of Allowance.

Respectfully submitted,

By 

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